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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,930	01/16/2004	Kulvir Singh Bhogal	AUS920030586US1	8211

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Dillon & Yudell LLP
P.O. Box 201720
Austin, TX 78720-1720

EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/759,930	Applicant(s) BHO GAL ET AL.	
	Examiner Laurie Ries	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 13 October 2006, to the Original Application filed 16 January 2004.
2. The rejection of claims 3-4, 14-15, 17, 20, 23-24 under 35 U.S.C. 112, second paragraph, has been withdrawn as necessitated by amendment.
3. Claims 1-35 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. The rejection of claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over Allam (U.S. Publication 2004/0139400 A1) has been withdrawn as necessitated by amendment and submission of evidence under 37 CFR 1.131.
5. Claims 1-35 are pending. Claims 1, 11, 21, and 31 are independent claims.

Response to Arguments

6. Applicant's arguments filed 13 October 2006 regarding the rejection of claims 1-35 under 35 U.S.C. 101 have been fully considered but they are not persuasive.

The Office maintains that independent claims 1, 11, 21, and 31 do not produce a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101. One technique for satisfying the requirements of 35 USC 101 is to clearly show a concrete, useful and tangible result, such as displaying a result to a user on a computer display device.

Affidavits/Declarations

7. The declarations filed on 13 October 2006 under 37 CFR 1.131 is sufficient to overcome the Allam reference.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claims 11 and 21, the language of these claims merely describes a computer program per se. As such, this raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101.

One technique for satisfying the requirements of 35 USC 101 is to claim code residing in memory (i.e., hardware), wherein that code produces a tangible result, such as displaying a result on a computer display device.

Regarding independent claims 1 and 31, the language of these claims merely describes non-functional descriptive material. As such, this raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101.

One technique for satisfying the requirements of 35 USC 101 is to claim code residing in memory (i.e., hardware), wherein that code produces a tangible result, such as displaying a result on a computer display device.

Dependent claims 2-10, 12-20, 22-30, and 32-35 are dependent upon claims 1, 11, 21, and 31, respectively, and do not add any limitations that would render the claims statutory under 35 USC 101. Therefore, these claims are likewise rejected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-10 and 21-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 1, it is unclear as to whether the bibliographical information recited in line 5, as "the bibliographical information" is the same bibliographical information recited in line 6, as "its associated bibliographical information linked thereto".

Regarding independent claim 21, it is unclear as to whether the bibliographical data recited in line 8, as "the bibliographical data" is the same bibliographical data recited in line 9, as "its associated bibliographical data linked thereto".

Dependent claims 2-10 and 22-30 are rejected for fully incorporating the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-10 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent 6,493,731 B1) in view of Microsoft Word.

As per independent claims 1 and 21 and dependent claims 2 and 22, Jones teaches a data processing system including a method for automatically providing bibliographical information associated with content including associating bibliographical information with content on an electronic page (See Jones, Figure 4, and Column 3, lines 5-12).

Jones does not teach expressly creating a copy of the content and dynamically including the bibliographical information within the copy of the content responsive to a copy function performed on the content, where the copy is created with its associated bibliographical information linked thereto. Microsoft Word teaches copying into a buffer from one document and pasting an object into a second document, where the source information is incorporated into the second document and is displayed, such as copying the "text" with a footnote using the copy command to a clipboard/buffer (See Microsoft

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Word, Figure 1) and doing a paste operation of the copied word "text", yielding the source information as footnoted being copied from Microsoft Word Figure 1 to Figure 2.

Jones further teaches storing documents (See Jones, Abstract).

Jones and Microsoft Word are analogous art because they are from the same field of endeavor of editing electronic textual data.

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jones to include copying from one document and pasting into another such that footnote information is also copied and pasted along with the copy/paste actions and displayed in the new document as taught by Microsoft Word. The motivation for doing this would have been to identify metadata about contents in a document and associate the metadata with the content (See Jones, Abstract). Therefore, it would have been obvious to combine Microsoft Word with Jones for the benefit of identifying metadata about contents in a document and associating the metadata with the content to obtain the invention as specified in claims 1-2 and 21-22.

As per dependent claims 3 and 23, Jones and Microsoft Word teach the limitations of claims 2 and 22 as described above. Jones also teaches requesting user selection of whether the bibliographical information should be inserted within the bibliographical section, and in response to requesting user selection to insert the information, updating a bibliographical section with the information, where when the user does not select insertion of the bibliographical information, the bibliographical section is not updated with the bibliographical information (See Jones, Figure 7, element 728, and Column 10, lines 14-16).

As per dependent claims 4 and 24, Jones and Microsoft Word teach the limitations of claims 3 and 23 as described above. Microsoft Word also teaches that the bibliographical information is tagged with an identifier, such as the number 1 preceding the word "text" at the bottom of Figure 1 (See Microsoft Word, Figure 1) and that the identifier is displayed with the copy of the content, such as the number 1 succeeding the phrase "This is Document text" in Figure 1 (See Microsoft Word, Figure 1). Jones also teaches that the content is selectable by a user and that the bibliographical information is displayed in response to the identifier being selected by the user (See Jones, Column 8, lines 8-14). Jones and Microsoft Word are analogous art because they are from the same field of endeavor of editing electronic textual data. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jones to include displaying identifiers with the content and the bibliographical information, as taught by Microsoft Word. The motivation for doing this would have been to identify metadata about contents in a document and associate the metadata with the content (See Jones, Abstract). Therefore, it would have been obvious to combine Microsoft Word with Jones for the benefit of identifying metadata about contents in a document and associating the metadata with the content to obtain the invention as specified in claims 4 and 24.

As per dependent claims 5 and 25, Jones and Microsoft Word teach the limitations of claims 2 and 22 as described above. Jones also teaches requesting user selection whether the bibliographical information is to be edited before insertion within the bibliographical section (See Jones, Figure 7, element 738, and Column 10, lines 25-29).

As per dependent claims 6 and 26, Jones and Microsoft Word teach the limitations of claims 5 and 25 as described above. Jones also teaches enabling the user to delete portions of the bibliographical information, and when a specified portion of the bibliographical information is designed for non-deletion, disabling a delete option for that specified portion (See Jones, Column 10, lines 29-39).

As per dependent claims 7 and 27, Jones and Microsoft Word teach the limitations of claims 6 and 26 as described above. Jones also teaches automatically deleting the content from the document when the specified portion of the bibliographical information is deleted (See Jones, Column 10, lines 10-17).

As per dependent claims 8 and 28, Jones and Microsoft Word teach the limitations of claims 1 and 21 as described above. Jones also teaches generating the content utilizing metadata and associating the bibliographical information as metatags within the metadata (See Jones, Column 2, line 67, and Column 3, lines 1-4).

As per dependent claims 9 and 29, Jones and Microsoft Word teach the limitations of claims 1 and 21 as described above. Jones also teaches that the bibliographical information includes name of author (See Jones, Figure 4, element 407).

As per dependent claims 10 and 30, Jones and Microsoft Word teach the limitations of claims 1 and 21 as described above. Microsoft Word also teaches that the bibliographical information is tagged with an identifier, or a comment, such as the number 1 preceding the word "text" at the bottom of Figure 1 (See Microsoft Word, Figure 1) and that the identifier or comment is displayed with the copy of the content, such as the number 1 succeeding the phrase "This is Document text" in Figure 1 (See

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Microsoft Word, Figure 1). Jones and Microsoft Word are analogous art because they are from the same field of endeavor of editing electronic textual data. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jones to include displaying identifiers or comments with the content and the bibliographical information, as taught by Microsoft Word. The motivation for doing this would have been to identify metadata about contents in a document and associate the metadata with the content (See Jones, Abstract). Therefore, it would have been obvious to combine Microsoft Word with Jones for the benefit of identifying metadata about contents in a document and associating the metadata with the content to obtain the invention as specified in claims 10 and 30.

11. Claims 11-19 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent 6,493,731 B1) in view of Microsoft Word and Burner (U.S. Patent 6,282,548 B1).

As per independent claims 11 and 31 and dependent claims 12-13, Jones teaches a system including a processor and memory coupled to the processor and including thereon program code (See Jones, Column 5, lines 57-65).

Jones also teaches including bibliographical information tracking mechanisms, such as using metadata (See Jones, Figure 4, and Column 3, lines 5-12).

Jones does not teach expressly a web browser allowing a user to select and copy content and a content editor for inserting content.

Burner teaches a web browser for displaying a web page (See Burner, Figure 1, element 130). It was well known in the art at the time of the invention that a web browser provides a mechanism for a user to select and copy content from a web page, such as using a standard cut and paste function.

Microsoft Word is a content editor and teaches copying into a buffer from one document and pasting an object into a second document, where the source information is incorporated into the second document and is displayed, such as copying the "text" with a footnote using the copy command to a clipboard/buffer (See Microsoft Word, Figure 1) and doing a paste operation of the copied word "text", yielding the source information as footnoted being copied from Microsoft Word Figure 1 to Figure 2.

Jones, Burner, and Microsoft Word are analogous art because they are from the same field of endeavor of editing electronic textual data.

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jones to include displaying a web page containing metadata as taught by Burner and copying from one document and pasting into another such that footnote information is also copied and pasted along with the copy/paste actions and displayed in the new document as taught by Microsoft Word. The motivation for doing this would have been to identify metadata about contents in a document and associate the metadata with the content (See Jones, Abstract, and Burner, Abstract) Therefore, it would have been obvious to combine Microsoft Word with Jones for the benefit of

identifying metadata about contents in a document and associating the metadata with the content to obtain the invention as specified in claims 11-13 and 31.

As per dependent claim 14, Jones, Burner, and Microsoft Word teach the limitations of claim 12 as described above. Jones also teaches requesting user selection of whether the bibliographical information should be inserted within the bibliographical section, and in response to requesting user selection to insert the information, updating a bibliographical section with the information, where when the user does not select insertion of the bibliographical information, the bibliographical section is not updated with the bibliographical information (See Jones, Figure 7, element 728, and Column 10, lines 14-16).

As per dependent claim 15, Jones, Burner, and Microsoft Word teach the limitations of claims 3 and 23 as described above. Microsoft Word also teaches that the bibliographical information is tagged with an identifier, such as the number 1 preceding the word "text" at the bottom of Figure 1 (See Microsoft Word, Figure 1) and that the identifier is displayed with the copy of the content, such as the number 1 succeeding the phrase "This is Document text" in Figure 1 (See Microsoft Word, Figure 1). Jones also teaches that the content is selectable by a user and that the bibliographical information is displayed in response to the identifier being selected by the user (See Jones, Column 8, lines 8-14). Jones, Burner and Microsoft Word are analogous art because they are from the same field of endeavor of editing electronic textual data. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jones and Burner to include displaying identifiers with the content and the bibliographical

information, as taught by Microsoft Word. The motivation for doing this would have been to identify metadata about contents in a document and associate the metadata with the content (See Jones, Abstract). Therefore, it would have been obvious to combine Microsoft Word with Jones and Burner for the benefit of identifying metadata about contents in a document and associating the metadata with the content to obtain the invention as specified in claim 15.

As per dependent claim 16, Jones, Burner, and Microsoft Word teach the limitations of claim 13 as described above. Jones also teaches requesting user selection whether the bibliographical information is to be edited before insertion within the bibliographical section (See Jones, Figure 7, element 738, and Column 10, lines 25-29).

As per dependent claim 17, Jones, Burner, and Microsoft Word teach the limitations of claim 14 as described above. Jones also teaches enabling the user to delete portions of the bibliographical information, and when a specified portion of the bibliographical information is designed for non-deletion, disabling a delete option for that specified portion (See Jones, Column 10, lines 29-39).

As per dependent claim 18, Jones, Burner, and Microsoft Word teach the limitations of claims 1 and 21 as described above. Jones also teaches generating the content utilizing metadata and associating the bibliographical information as metatags within the metadata (See Jones, Column 2, line 67, and Column 3, lines 1-4).

As per dependent claim 19, Jones, Burner, and Microsoft Word teach the limitations of claims 1 and 21 as described above. Jones also teaches that the bibliographical information includes name of author (See Jones, Figure 4, element 407).

As per dependent claims 20 and 32, Jones, Burner, and Microsoft Word teach the limitations of claims 18 and 31 as described above. Microsoft Word also teaches that the bibliographical information is tagged with an identifier, or a comment, such as the number 1 preceding the word "text" at the bottom of Figure 1 (See Microsoft Word, Figure 1) and that the identifier or comment is displayed with the copy of the content, such as the number 1 succeeding the phrase "This is Document text" in Figure 1 (See Microsoft Word, Figure 1). Jones, Burner, and Microsoft Word are analogous art because they are from the same field of endeavor of editing electronic textual data. At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Jones and Burner to include displaying identifiers or comments with the content and the bibliographical information, as taught by Microsoft Word. The motivation for doing this would have been to identify metadata about contents in a document and associate the metadata with the content (See Jones, Abstract). Therefore, it would have been obvious to combine Microsoft Word with Jones and Burner for the benefit of identifying metadata about contents in a document and associating the metadata with the content to obtain the invention as specified in claims 20 and 32.

As per dependent claim 33, Jones, Burner, and Microsoft Word teach the limitations of claim 31 as described above. Jones also teaches that the bibliographic

identifier includes metatags linked to the bibliographical data (See Jones, Column 2, line 67, and Column 3, lines 1-4).

As per dependent claim 34, Jones, Burner, and Microsoft Word teach the limitations of claim 31 as described above. Jones also teaches selecting at least one level of deletion capability for the bibliographic identifier, where a first level allows a copier to separate and delete the bibliographical data from the content and a second level prevents removal of the bibliographical data by a copier (See Jones, Figure 7, elements 724 and 736).

As per dependent claim 35, Jones, Burner, and Microsoft Word teach the limitations of claim 31 as described above. Jones also teaches enabling a copy tracking mechanism within the bibliographic identifier, where an Internet identification (ID) of a copier of the content is recorded at a computer on which the web page is hosted (See Jones, Column 3, lines 7-12).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Keohane (U.S. Publication 2003/0229858 A1) discloses a method and apparatus for providing source information from an object originating from a first document and inserted into a second document.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER